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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/311,674	05/13/1999	PENINA KATZ	WMA-96-015AA	1540

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WORLDCOM, INC.
TECHNOLOGY LAW DEPARTMENT
1133 19TH STREET NW
WASHINGTON, DC 20036

EXAMINER

MEINECKE DIAZ, SUSANNA M

ART UNIT	PAPER NUMBER
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3623

DATE MAILED: 12/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/311,674

Applicant(s)

KATZ, PENINA

Examiner

Susanna M. Diaz

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 July 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

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DETAILED ACTION

1. This Final Office action is responsive to Applicant's amendment filed July 2, 2003.

Claims 30-32 have been cancelled.

Claims 1-29 are pending.

2. The previously pending objection to claims 30-32 is withdrawn in response to Applicant's cancellation of claims 30-32.

Response to Arguments

3. Applicant's arguments filed July 2, 2003 have been fully considered but they are not persuasive.

Applicant argues:

However, what is conspicuously absent from *Oliver* is any use of a "reference database," much less a reference database used for verifying identification data **"against reference data stored in a reference database"** as recited in claims 1 and 8 (see similar language in claim 29). Furthermore, *Oliver* has no teaching or suggestion for **"comparing the indicated origin of each of said telephone calls with information associated with valid work sites"**, as positively recited in noted independent claims 9, 16, 25, and 27. (Page 3 of Applicant's response)

The Examiner respectfully submits that, in order for a personal identification number (PIN) to serve as identification of the person entering a PIN, there must be an understood correlation between the PIN and the person to whom the PIN is assigned

(i.e., ideally the person entering the PIN into the system). It was well understood to one of ordinary skill in the art at the time of Applicant's invention that, once a person enters a PIN, the PIN is matched to an entry in a database (i.e., any collection of data) in order to find the identification corresponding to the entered PIN. More specifically, Oliver states that a "computer is provided to store line status information, preset numbers, personel [sic] identification (PIN) numbers and telephone set locations to provide a universal software controlled monitoring of locations, telephone sets and personnel wherever [sic] telephone sets are located" (Abstract). The fact that Oliver's PIN numbers are stored in a computer is indicative of the verification of a person's identification against reference data (i.e., PIN data) stored in a reference data base (i.e., a collection of data stored on the computer). Similarly, the fact that Oliver's telephone set locations are stored in a computer in order "to provide a universal software controlled monitoring of locations, telephone sets and personnel wherever [sic] telephone sets are located" (Abstract) is indicative of the comparison of an indicated origin of each of the telephone calls with information associated with valid work sites. Therefore, Applicant's arguments are non-persuasive.

Applicant argues that the disclosure of Hedges "falls short of providing 'origin of each of said telephone calls,' much less comparing 'the indicated origin of each of said telephone calls with information associated with said identification data.'" (Page 4 of Applicant's response) Examiner respectfully disagrees. As set forth in the art rejection, Hedges explicitly teaches:

The portable unit includes a receiver 50, a transmitter 52 and a dialer 54, which are shown in block diagram form in

FIG. 5. The transmitter 52 includes a circuit which is connected through the connectors 39 and 40 to a unique coding circuit 53 in the particular receptacle 25 to which it is interconnected to provide a room code for identifying the particular room from which a transmission takes place. (*Emphasis added*, Col. 6, lines 15-20)

Clearly, Hedges' portable unit is understood to be making a call from the particular room in which the transmission takes place; therefore, Hedges does indeed teach the provision of an "origin of each of said telephone calls."

Applicant further asserts:

...First, the portable unit of the *Hedges* system does not in fact identify the telephone set, but the portable unit itself and the room (col. 5: 40-43; col. 6: 13-20). Therefore, the extrapolation of the functions of the portable unit to ANI and caller ID is technically without merit. As for the second point, Applicant notes that ANI and caller ID are network based services; thus, the modification that the Office Action is suggesting to *Hedges* is no mere use of modern technology, in that the *Hedges* system provides no suggestion on identifying the room using network services, merely contemplating providing such function with the portable unit. (Page 5 of Applicant's response)

Examiner respectfully disagrees. First, Hedges' portable unit functions as a telephone set since it is used by personnel, such as maids, to communicate (i.e., call in) hotel room status via a telephone network (Abstract). Therefore, the location of the portable unit is understood to be the same as the location of the claimed telephone set. Second, a communication channel comprising telephone lines (as disclosed in the Abstract) is a type of network. Furthermore, ANI and caller ID are services specifically offered for telephone number identification (i.e., identification of the telephone unit and

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location from which a call originates, noting that an area code and address corresponding to a residential phone line both specify locations) via telephone lines. Hedges too provides the identification of the location of a portable unit (i.e., telephone unit) from which a communication (i.e., a call) originates; therefore, Examiner maintains that ANI and caller ID technology indeed exemplify mere uses of analogous modern technology, especially in light of the fact that Hedges was filed in 1972 -- eighteen years before Applicant's earliest priority date of 1990.

In conclusion, Applicant's arguments are deemed to be non-persuasive and the art rejections are maintained.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. **Claims 1-6, 8-13, 15-22, 24-32** are rejected under 35 U.S.C. 102(e) as being anticipated by **Oliver (US Pat. No. 4,839,917)**.

As to **claims 1-4, 8, 9, 15, 16-20, 24-32**, Oliver teaches a method and system for personnel tracking (col. 13, ln. 3). The employee calls from various work locations with the employees PIN and the call is recorded including the location, employee ID, and the time of the call (i.e., if the employee does not call within a specified time, an alarm is generated). (col. 13, lns. 5-21).

As to **claims 5, 6, 10-13, 21, 22**, Oliver teaches using PBX system to automatically detect the call's origin and location. Therefore, Oliver teaches the equivalent of ANI and caller ID systems at the time of the invention and therefore is considered to be inherent in Oliver to use any equivalent device to obtain the same result.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. **Claims 1-32** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Hedges (US Pat. No. 3,819,862)**.

As to claims **1-4, 8, 9, 15-20, 24-32**, Hedges teaches a method and system for tracking employees (col. 1, Ins. 18-20, 22-29). The employees call in from various worksites (e.g., different rooms in a hotel; col. 6, Ins. 15-20) from a telephone, which has connected thereto a device that transmits location information (col. 6, Ins. 15-20; col. 11, In. 15), employee information (col. 11, Ins. 47-50), and nature of the call (e.g., beginning a task, ending a task, or inspecting the job performed; col. 12, Ins. 14-26) to a central computer (col. 2, Ins. 3-4, 43-48; col. 3, Ins. 36-39) which collects the data for providing a record to be monitored and printed by the management (col. 6, Ins. 1-3).

Hedges does not specifically teach that the call is time stamped. However, examiner takes Official Notice that it is notoriously old and well known to time stamp calls that are received to verify when a call was accepted. (See references already of record. Almost every single one teaches that it is old and well known to time stamp call records for various purposes). One would have been motivated to time stamp the calls as disclosed in Hedges because Hedges teaches that one of the desires in the hotel industry is that the "supervisory personal know where the maintenance personnel are and **when** the maintenance in a particular room is completed." (col. 1, Ins. 27-29, emphasis added). It is notoriously old and well known to one of ordinary skill in the hotel management art that "when" a room is ready includes not only whether a room is currently ready, but at what instant (i.e., time) a room became ready in order to assess how long a room as gone by without being booked. It is also notoriously old and well known that management keeps track of how long it takes for a room to be ready in order to assess performance levels of their employees. Consequently, it would have been

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obvious for one of ordinary skill in the art at the time of the invention to have time stamped the calls from the employees to determine "when" a room becomes available as taught by Hedges.

As to **claims 5, 6, 10-13, 21, 22**, Hedges does not specifically teach that the telephone uses ANI or caller ID to determine the original or location of the calls. However, the mechanism for which Hedges uses to determine the telephone and location of the calls are the equivalent of ANI and call ID systems at the time of the invention. In particular, Hedges teaches that a device is used to transmit an ID of the telephone set to the computer, the telephone ID being associated with a particular room. This is the same principle on which ANI and caller ID is based. Hedges being a 1974 patent, it would have been obvious to one of ordinary skill in the art at the time of the invention to have appreciated that ANI and caller ID, both being notoriously well known at the time of the invention to identify the caller/location, is the equivalent of the device used by Hedges to identify the location of the call. Hence, one with ordinary skill in the art would have been motivated to use a well known, more modern technology at the time of the invention to perform the same functionality as taught by Hedges.

As to **claims 7, 14, 23**, Hedges does not teach that the telephones used are cellular phones. However, Hedges does teach using alternative communicating devices, such as the television cable, to communicate with the central computer. Cellular phones are modern versions of land-based telephones with the same features but wireless. Hence, one with ordinary skill in the art would have been motivated to use

a well known, more modern technology at the time of the invention to perform the same functionality as taught by Hedges.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susanna M. Diaz whose telephone number is (703) 305-1337. The examiner can normally be reached on Monday-Friday, 9 am - 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on (703) 305-9643.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703)308-1113.

Any response to this action should be mailed to:

**Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450**

or faxed to:

(703)305-7687 [Official communications; including
After Final communications labeled
"Box AF"]

(703)746-7048 [Informal/Draft communications, labeled
"PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 22202, 7th floor receptionist.

Susanna Diaz
Susanna M. Diaz
Primary Examiner
Art Unit 3623
December 8, 2003